

**REMARKS**

In the Office Action, claim 36 was noted as the sole claim pending in the application, and claim 36 was rejected. By this Response, no claims have been canceled, amended, or added. Thus, claim 36 is pending in the application. The objections and rejections of the Office Action are traversed below.

**Rejection of Claim 36 under 35 USC §112**

On pages 2 - 3 of the Office Action, claim 36 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention unpatentable. This rejection is respectfully traversed.

The Office Action asserts that the "implicit training module" feature recited in claim 36 is unclear. In particular, the Office Action asserts that it is unclear what the training module is configured to do. The Applicant notes that the implicit training module is "configured to continually watch text selected by a user while working," as set out in lines 5 - 6 of claim 36. This feature is disclosed in the specification at least at page 6, line 17; page 10, lines 5 - 6; and page 15, lines 20 - 29. See declaration at ¶ 3.

The two recited features of "having an assigned priority" and "comprising new training messages to the text classifier" are each directed to the "selected text" (and not the implicit training module). A comma was inserted in the claim after "a user while working" and in front of "the selected text" to specify that the "assigned priority" and the "new training messages" apply to the "text selected by a user." Therefore, claim 36 as written claims the implicit training module is configured to continually watch text selected by a user while the user is working (see lines 5 - 6 of claim 36). Claim 36 also claims the selected text as having an assigned priority and further claims the selected text as comprising new training messages to the text classifier (see lines 6 - 7 of claim 36). See declaration at ¶ 3.

The Office Action further asserts that the derivation of the term, "assigned priority," in line 6 of claim 36 is unclear. The Applicant respectfully directs the Examiner to the specification at page 15, lines 20 - 29; page 16, lines 20 - 25; and page 26, lines 11 - 13 and to the declaration at ¶ 4. Text which is to have a priority assigned is received by exemplary

embodiments of the system (page 26, line 11). A priority for each text is generated by the text classifier (page 26, line 13 and page 16, lines 20 - 21), is assigned to the text (page 16, line 21 and page 26, line 11), and is output to storage (page 26, line 16). The user selects the prioritized text while the system watches; and the text classifier is periodically updated, with the selected prioritized text constituting new training messages to the text classifier (page 15, lines 20 - 29).

In view of the above explanation and the evidence presented in the declaration of John Platt, withdrawal of the rejection of claim 36 is respectfully requested.

#### **Declaration of an Interference**

The Office Action asserts on pages 3 - 4 that there is a distinction between two features of the Nelken patent and the corresponding recited features of the present application. In particular, the Office Action compares the "task queue" of Nelken with the "storage media" of the present application and also compares the "task" of Nelken with the "text" of the present application.

As an initial matter, the Applicant notes that declaration of an interference involves finding the same claimed subject matter in, such as the present case, both an issued patent and a pending patent application. Whether the claimed subject matter is the "same" is based on the standard of obviousness, in that each of the two claimed inventions would be obvious in view of the other claimed invention. However, the two claimed inventions need not be identical in language or scope for an interference to exist. As the Examiner knows from her experience examining patent specifications, two specifications can disclose and claim the same subject matter while using different terms and descriptions. The patent and the application at issue here are just such an example, where both claimed systems are directed to a text prioritization system but use different terms to describe the systems.

As to the question of the terms "task queue" and "storage media," "queue" is a well known term in the art of computer systems for describing a data structure for storing information in sorted order. See Webster's Computer & Internet Dictionary 460 (Random House, 3d ed. 1999); Dictionary of Electronics and Computer Technology 429 (McGraw-Hill, 3d ed. 1984). See also declaration at ¶ 6. Contrary to the assertions of the Office

Action, a queue does not indicate the presence of a software algorithm any more than does storage media. Instead, in the context of the disclosures of the Nelken patent and the present application, the "task queue" and "storage media" terms are being used in an equivalent manner. See declaration at ¶ 6. Software algorithms for ordering objects can be designed to write data equally onto queues and onto storage media, read data from the same, and process data residing on such devices. It is not the task queue vis-à-vis the storage media that provides the software priority capabilities of Nelken, as asserted in the Office Action. Instead, it is the software priority module of the decision engine of Nelken that determines the priority of the tasks for storage in the task queue (Col. 3, lines 43 - 47; Col. 4, lines 39 - 40; Col. 6, lines 3 - 8). See declaration at ¶ 6. Assuming, *arguendo*, that the task queue is inseparable from a software algorithm for determining stored task priority, as inferred by the Office Action, then stored tasks could only be selected from the queue according to the tasks' priorities. However, Nelken clearly permits an agent to select tasks from storage regardless of their priority (see Col. 2, lines 1 - 6; Col. 6, lines 18 - 23), as does the present invention (see application at page 15, lines 20 - 29). Both the task queue of Nelken and the storage media of the present application permit the storage of prioritized text and the subsequent selection of text in an order determined by the user, which is not necessarily the order dictated by the priority (Nelken at Col. 3, lines 43 - 47; Col. 4, lines 8 - 10; Col. 5, lines 1 - 11) (application at page 15, lines 20 - 29; Col. 25, lines 8 - 9). See declaration at ¶ 6.

Regarding the terms "task" and "text," the Applicant respectfully asserts that the ordinary and customary definition of a "task" is an action or a function to be performed or being performed. See Webster's Computer & Internet Dictionary 547 (Random House, 3d ed. 1999); The American Heritage Dictionary 1245 (Houghton Mifflin Company 2d College ed. 1985). See declaration at ¶ 7. The specification of the Nelken patent expressly supports this definition at Col. 1, lines 47 - 48, where a task is defined to include "an action that is to be performed by an agent or an electronic system." However, Nelken, as his own lexicographer, has expressly and unambiguously extended this definition by disclosing that, as far as his system is concerned, a task "may be a piece of data that must be acted on in some fashion" (Col. 1, lines 49 - 50). Notwithstanding this, both the intrinsic and the extrinsic evidence associated with the Nelken patent clearly limit the claim element "task" as recited in claim 1

to text to be prioritized, which is also the subject matter of the present application, as discussed below. See declaration at ¶¶ 7, 8.

The sole claim of Nelken recites a system for automatic task prioritization that includes a decision engine configured to receive and prioritize tasks and a task queue to store the prioritized tasks (Col. 3, lines 36 - 45). At Col. 1, lines 53 - 57, Nelken discloses that the decision engine responsible for receiving and assigning a priority to each task includes a natural language processor for parsing text into concepts and relationships. As is well known in the art of language processing, a natural language processor is structured to process text expressed in a natural language (see Nelken at Col. 1, lines 56 - 57) and is not equipped to process or interpret an action, whether the action is a physical movement by an agent or the abstraction of an action to be performed in the future. See declaration at ¶ 9. The preferred embodiment of Nelken has a task parser that includes a natural language processor for analyzing the content of text communications expressed in a natural language (Col. 4, lines 24 - 26). It is the task parser that forwards each parsed task to a priority module for comparing the parsed tasks with its priority data and for assigning a priority to each task (Col. 4, lines 38 - 40). The only disclosed path for sending a task to the priority module is from the task parser (Figure 3; Col. 4, lines 38 - 39), and the only disclosed method for parsing each received task into the required concepts, relationships, and keywords is with the natural language processor of the task parser (Figures 3 & 4; Col. 4, lines 19 - 29; Col 5, lines 41 - 49). Furthermore, there is no disclosure within Nelken describing how an "action" could be parsed into concepts, relationships, and keywords, unless the action was in the form of textual data. See declaration at ¶ 9.

As further intrinsic evidence of the intent within Nelken to limit the claimed tasks to text-based communications and not actions, the Applicant points to Col. 2, at lines 55 - 59. Here Nelken notes that communications received by its contact center may be in the form of tasks. Nelken expressly limits these received tasks to text-based communications in the following sentence by stating that "[a]lthough tasks in particular are discussed here, other types of text-based communications, for example remote employees' reports, are within the scope of the invention" (emphasis added). In other words, tasks are disclosed within the Nelken patent as being a species of text-based communications. See declaration at ¶ 10.

Nelken goes on to note that its contact center can receive voice communications, but that any such voice communications are converted into text prior to processing by its prioritization system (Col. 2, lines 59 – 63). See declaration at ¶¶ 11, 12.

Additionally, there is existing extrinsic evidence that is consistent with interpreting the claimed "task" feature to be limited to the prioritization of only text. Banter, Inc., the assignee of the Nelken patent, issued press releases shortly after the issuance of the Nelken patent, asserting that the issued patent "lets companies better handle large volumes of e-mail" and that the patented system is "a component of its natural language technology" for managing large volumes of e-mail. Copies of two of the press releases, both dated July 10, 2002, are attached.

The Office Action further asserts that there is a distinction between Nelken and the present invention in that "Nelken teaches monitoring how tasks are selected from the 'task queue' whereas the present invention teaches watching the user's interaction with text and prioritizing according to the tracking and then feeding that back to the text classifier." (Office Action at page 4). The Applicant respectfully disagrees and asserts that there is no distinction between the monitoring and reprioritizing functions claimed by Nelken and by the present invention. Both systems provide for monitoring text selected by a user from storage (Nelken at Col. 3, lines 10 - 12; Col. 5, lines 1 - 4; Col. 6, lines 11 - 18) (application at page 8, lines 5 - 15; page 15, lines 20 - 27). Both systems then utilize the text selection information to update the guidelines for determining the priority of received text (Nelken at Col. 2, lines 1 - 6; Col. 5, lines 4 - 13; Col. 6, lines 18 - 22) (application at page 15, lines 26 - 30; page 26, lines 11 - 15). See declaration at ¶¶ 13, 14.

The Applicant respectfully asserts that claim 1 of Nelken and claim 36 of the present application are claiming the same invention even though their respective specifications use some different terms. The Applicant respectfully asks that the Request for Declaration of an Interference be reconsidered in light of the above remarks and the declaration of John Platt.

**Summary**

It is submitted that the sole claim remaining in the application, namely claim 36, satisfies the requirements of 35 U.S.C. § 112, as discussed above. It is further respectfully asserted that the Request for Declaration of an Interference satisfies the requirements of 37 C.F.R. § 1.607, including two-way obviousness of the features recited in Nelken's claim 1 and claim 36 herein. Reconsideration of the claim and the Request for Declaration of an Interference is earnestly solicited. Should the Examiner have any questions or comments on any of the above, she is respectfully invited to contact the undersigned. If any fees are required in connection with this Amendment, please charge the same to our Deposit Account No. 02-4800.

Respectfully submitted,

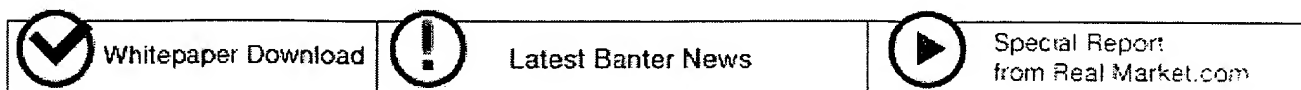
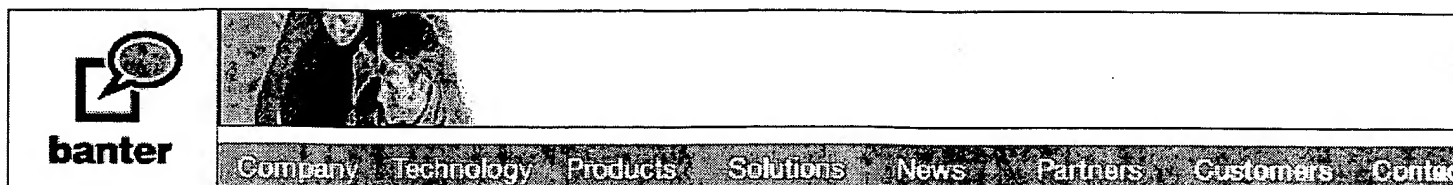
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## Banter Granted Patent for Key Function of Natural Language Technology

*Innovation covered by patent found in flagship product, Banter Server*

### FOR IMMEDIATE RELEASE

**SAN FRANCISCO (July 10, 2002)** Banter, Inc., the leading provider of technology that understands people, today announced that it received approval of a patent for a component of its natural language technology that greatly increases the speed and efficiency of Global 2000 corporations' customer service operations.

The patent - U.S. patent number 6,408,277 granted to Banter on June 18 - covers Banter's system and method to automatically prioritize tasks, enabling companies to scale their ability to better handle large volumes of e-mail, improve customer service quality and decrease costs.

The patented task prioritization system is part of Banter's industry-leading infrastructure technology that understands informal written communication and enables applications to automate the appropriate action such as responding, routing, prioritizing, categorizing and filtering.

Global 2000 customer service organizations can implement Banter's patented technology through Banter Server, an infrastructure platform for easy and fast deployment; Banter Workbench, a toolset for text mining, reporting and knowledge base creation; and Banter RME, an embeddable version of Banter's core technology.

Used by companies like Siebel, Peregrine, Wells Fargo and Royal Bank of Canada, Banter's technology improves quality while lowering the cost of customer service, as consumers use a self-service Web site, Web forms or e-mail to receive quick and accurate answers to their questions.

Going beyond the customer service organization, Banter solutions enable enterprises to deal with the growing epidemic of e-mail overload. Banter has been at the forefront of addressing this problem by extending its capabilities found in customer service and CRM applications to managing corporate e-mail.

"This patent is another indication of Banter's leadership and innovation in Web self-service and smart e-mail management markets," said Yoram Nelken, chairman and chief technology officer of Banter. "Enterprises are realizing that current methods of managing e-mail are insufficient to deal with the vast explosion of written communication and that

smarter, adaptive mechanisms must be put in place."

Banter's technology, that understands informal written communication, is also used to mine e-mail streams, block inappropriate messages, block spam or assure compliance with regulations and rules.

**About Banter**

Banter provides technology that understands people. Enterprise organizations can manage e-mail flows, enforce policies, improve customer service quality and lower customer contact overhead by using Banter's infrastructure technology to accurately understand written communication and enable appropriate response or action. Banter's core technology is Banter RME, which is the only linguistic and statistical engine that teaches itself to be more accurate over time without requiring costly human intervention. Banter's technology is being used by the customer service operations of companies like Royal Bank of Canada, Wells Fargo, VeriSign, ABN AMRO, Nintendo, and others. Banter also partners with software leaders Siebel, Peregrine, Avaya and many others. For more information about how Banter can help your business, please visit the company's website at <http://www.banter.com> or call toll free 1-877-992-2683.

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July 10, 2002  
**Banter Server A  
 Natural For Patent**  
 By Michael Singer

Banter Inc. Wednesday said it has received approval of a patent for a component of its natural language technology for use in its servers.

U.S. patent number 6,408,277 covers Banter's system, which automatically prioritizes tasks and lets companies better handle large volumes of e-mail.

The prioritization system is a key part of the San Francisco-based company's Banter Server, an infrastructure platform; Banter Workbench, a toolset for text mining, reporting and knowledge base creation; and Banter RME, an embeddable version of



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